

APR 03 2007

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Anderson et al.

Application No: 09/401,070

Filed: September 22, 1999

Title: Accessory Interface Bus for Telephone
Headset Adapter

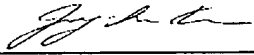
Attorney Docket No. 01-3876

Examiner: Ryman, Daniel J

Art Unit: 2665

CERTIFICATE OF MAILING OR TRANSMISSION

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Signed: 
Typed Name: Jung-hua Kuo

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection mailed on April 19, 2006 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets (3 pages).

Note: No more than five (5) pages may be provided.

I am the:

- ☒ attorney or agent of record. Registration Number 44,780.
☐ attorney or agent acting under 37 CFR 1.34. Registration Number _____.
☒ If the required fees are missing or any additional fees are required during the pendency of the subject application, please charge such fees or credit any overpayment to Deposit Account No. 50-2315 (Order No. 01-3876). A copy of this sheet is enclosed.

Respectfully submitted,

April 3, 2007
Date



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In re the application of: Anderson et al.

Application No: 09/401,070

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Title: Accessory Interface Bus for Telephone
Headset Adapter

Atty. Dkt. No. 01-3876(PLANP014)

Examiner: Ryman, Daniel J

Assignee: Plantronics, Inc.

Art Unit: 2665

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Signed: 

Name: Jung-hua Kuo

Reasons For Pre-Appeal Brief Request For Review

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The reasons for the Pre-Appeal Brief Request for Review are set forth below.

In rejecting claims 1-3, 14-16, 26-40, 63, 66, 67, 70, 71, 75, and 76 under 35 U.S.C. §103(a), the Examiner did not establish that Endick et al. (USPN 5,339,360) in view of admitted prior art renders the claimed inventions obvious

Claims 1-3, 14-16, 26-40, 63, 66, 67, 70, 71, 75, and 76 were rejected under 35 U.S.C. §103(a) as being unpatentable over Endick in view of Applicant's admitted prior art. However, the Examiner did not establish that Endick in view of admitted prior art discloses or suggests each and every element of the claimed invention to render the claims obvious.

The Examiner had indicated that the prior art neither discloses nor fairly suggests that a headset adapter independently and directly controls the headset accessory (Office Action mailed July 6, 2005, page 25, paragraph 53 (in reference to the indication that claims 15-25 would be allowable if rewritten or amended to overcome the rejection under 35 USC 112, 2nd paragraph)).

These pending claims are believed to recite that the headset adapter independently and directly controls the headset accessory. However, in the final Office Action mailed October 3, 2006 (paragraph 3 of "Response to Amendment" on pages 2-3), the Examiner states that claim 1 does not positively recite independent and direct control and/or monitoring by the headset

adapter because the accessory is recited as being “configured to be coupled to the accessory interface bus of the adapter.” In particular, the Examiner states “‘configured to’ is language that makes optional, but does not require, the subsequent limitation.” In claim 1, while “configured to” does not require the accessory to be presently coupled to the accessory interface bus, it does require that the accessory be capable of being coupled to the accessory interface bus. The Examiner then concludes that “since the accessory is not required to actually couple to the bus, and thus be ‘in communication with the headset adapter,’ the accessory is also not required to be independently and directly controlled and monitored by the headset adapter.”

However, if the prior art does not disclose or fairly suggest that a headset adapter independently and directly controls the headset accessory, then it clearly follows that a headset system that includes a headset adapter *configured to* independently and directly control the headset accessory is neither anticipated nor rendered obvious by the prior art.

The Examiner would require that a system to be *currently performing all the recited functions*, rather than a system that is *configured to* or capable of performing the functions, in order to overcome the prior art that neither discloses nor fairly suggests those recited functions. In other words, the Examiner has imposed the requirement that if the claim recites a system that is simply not powered up or turned on or even just sitting idle, but otherwise *capable of* performing functions not disclosed or suggested by the prior, then the system would not be new nor nonobvious.

Withdrawal of the rejection of claims 1-3, 14-16, 26-40, 63, 66, 67, 70, 71, 75, and 76 under 35 U.S.C. §103(a) is respectfully requested.

In rejecting claims 9, 10, 21, 22, 43, 49, and 69 under 35 U.S.C. §103(a), the Examiner did not establish that Endick et al. (USPN 5,339,360) in view of admitted prior art and further in view of Waechter (USPN 4,943,963) or Miesterfeld et al (USPN 4,706,082) renders the claimed inventions obvious

The deficiencies of Endick are not overcome with the addition of the additional reference of Waechter or Miesterfeld. These dependent claims are believed to be allowable at least for the similar reasons as set forth above with regard to Endick as discussed above. Thus, withdrawal of the rejection of claims 9, 10, 21, 22, 43, 49, and 69 is respectfully requested.

In objecting to various claims, the Examiner did not establish

Various claim objections are to the language “configured to” and are believed to be in error as it is believed that such language constitutes proper claim language.

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Applicants note that claim 45 should be dependent from claim 40 as was originally filed. If the other objections and the rejections are withdrawn, an Examiner's amendment is respectfully requested or, alternatively, an amendment will be submitted to correct the obvious typographical error.

CONCLUSION

Because the Examiner's rejections of claims 1-4, 6, 7, and 57-66, 73, and 74 include legal deficiencies with regard to under 35 U.S.C. §103(a) and the MPEP, Applicants are entitled to a pre-appeal brief review of the final rejection. And based on the foregoing arguments, Applicants request that the rejection of these claims be withdrawn and the pending claims be allowed.

In the unlikely event that the transmittal letter accompanying this document is separated from this document and the Patent Office determines that an Extension of Time under 37 CFR 1.136 and/or any other relief is required, Applicant hereby petitions for any required relief including Extensions of Time and/or any other relief and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-2315 (Order No. 01-3876).

Respectfully submitted,



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